REMARKS

Reconsideration of the restriction requirement of the present application is respectfully requested.

Restriction Requirement

Applicants elect Group I with traversal. As grouped by the Examiner, Group I contains Claims 1-6, and 9-10.

The Examiner has alleged that the following groups of claims do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical feature.

Group I – Claims 1-6, and 9-10 drawn to an enantiomeric specific method.

Group II – Claims 7-8 drawn to a mutated enzyme.

Group III – Claims 11-13 drawn to epoxides.

The rules for applying the PCT's unity of invention standard are set forth in MPEP § 1850 which states that there is unity of invention where there is "a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features." PCT Rule 13.2; MPEP § 1850. "Special technical features" means "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." PCT Rule 13.2; MPEP § 1850.

Here, the Examiner appears to be arguing that since there are pure epoxides and that the native enzyme is not novel, there is no single special technical feature that is shared between the claims. Applicants respectfully submit that the Examiner is misapplying the PCT unity of invention standard, and misinterpreting Applicants' claimed invention.

In fact, the MPEP specifically permits the inclusion of Claim Groups I, II, and III in the same application. "The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular . . . an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process." MPEP § 1850. That is the case here. Group III (Claims 11-13) is drawn to a given product, namely an epoxide. Group I (Claims 1-6, and 9-10) is drawn to a process

specially adapted for the manufacture of the epoxides of Group III. Finally, Group II (Claims 7-8) is drawn to a means specifically designed for carrying out the said process – a mutated form of a non-haem diiron monooxygenase for producing enantiomers of an epoxide. Accordingly, as per the MPEP, this combination of claim groups is permitted under the unity of invention standard.

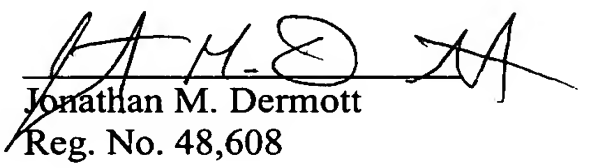
Moreover, Applicants traverse the restriction requirement as the three groups of claims are clearly within the unity of invention standards as set forth in the PCT rules and MPEP § 1850. It is first noted that the Examiner who completed the PCT International Preliminary Examination Report did not find lack of unity in the claims even though the claims examined are identical to the pending claims of the present application. See PCT International Preliminary Examination Report dated March 26, 2001.

The claims of the present application are directed to methods for converting alkenes into enantio-specific epoxides by the use of non-haem diiron-containing monooxygenases, compounds produced by such enzymes, and mutated forms of such enzymes. The special technical feature of each claim group is the use of non-haem diiron-containing monooxygenase to create enantiomers of an epoxide. Accordingly, the groups of claims all share a special technical feature and thus do not lack unity of invention under the PCT rules.

For the reasons given above, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

The Commissioner is authorized hereby to charge any fees or credit any overpayment associated with this Reply (copy enclosed) to Deposit Account Number 19-5425.

Respectfully submitted,



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